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10/715,265

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Kevin Currans

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INTELLECTUAL PROPERTY ADMINISTRATION

FORT COLLINS, CO 80527-2400

EXAMINER

DURNFORD GESZVAIN, DILLON

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                |  |
|------------------------------|--------------------------------------|--------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/715,265        | Applicant(s)<br>CURRANS, KEVIN |  |
|                              | Examiner<br>Dillon Durnford-Geszvain | Art Unit<br>2622               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/26/04, 3/16/07</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims **23** and **24** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material."... "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas

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because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.”) (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) (“form of the claim is often an exercise in drafting”). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

Claims **23** and **24** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims **23** and **24** define a data storage device with descriptive material. While “functional descriptive material” may be claimed as a statutory product (i.e., a “manufacture”) when embodied on a tangible computer readable medium, non-functional descriptive material is considered a mere arrangement of data and therefore does not satisfy the requirements of 35 USC 101.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims **1-6, 8-17** and **19-22** are rejected under 35 U.S.C. 102(e) as being anticipated by US 2004/0114042 (Paolini et al.).

As to claim **1**, Paolini et al. teaches a method of correlating an image with information associated with the image comprising: identifying image metadata for the image ([0032]), wherein the image metadata includes information associated with conditions at the time of image capture ([0030] lines 2-4); and searching one or more information sources using parameters in the image metadata to collect inference information from the information sources ([0032]).

As to claim **2**, see the rejection of claim **1** and note that Paolini et al. further teaches the method of claim **1** further comprising: receiving one or more inputs from the user identifying selected inference information; and adding the selected inference information to an image file for the image ([0021], see the last 4 lines, [0033] lines 4-7, and [0035] and note that the search is user controlled).

As to claim **3**, see the rejection of claim **1** and note that Paolini et al. further teaches the method of claim **1** further comprising: receiving one or more inputs from the user identifying selected inference information; and adding the selected inference information to an inference metadata file linked to the image [0021], see the last 4 lines, [0033] lines 4-7, and [0035] and note that the search is user controlled).

As to claim **4**, see the rejection of claim **1** and note that Paolini et al. further teaches the method of claim **1** wherein the image metadata includes parameters selected from the group consisting of: time of image capture; date of image capture;

location of image capture ([0030]); direction of image capture device during image capture; and angle of image capture device during image capture.

As to claim 5, see the rejection of claim 1 and note that Paolini et al. further teaches the method of claim 1 wherein the image metadata includes a latitude and longitude of the image capture device ([0018]).

As to claim 6, see the rejection of claim 1 and note that Paolini et al. further teaches the method of claim 1 wherein the image metadata includes location information generated by tracking multiple earth-orbiting satellites ([0018] and note that the GPS used by Paolini et al. inherently uses multiple earth orbiting satellites).

As to claim 8, see the rejection of claim 1 and note that Paolini et al. further teaches the method of claim 1 wherein the inference information is selected from the group consisting of: landmarks located near the image ([0018]); weather at the time of image capture; information related to the location where the image was captured; and objects that are within the field of view of the image capture device ([0018], and [0033] which describes retrieving those names from a database).

As to claim 9, see the rejection of claim 1 and note that Paolini et al. further teaches the method of claim 1 further comprising: searching a first database (a local database) using the image metadata to identify the inference information ([0032]); and searching a second database (a web-based database, for example) using the inference information to identify additional inference information ([0034]).

As to claim **10**, see the rejection of claim **1** and note that Paolini et al. further teaches the method of claim **1** wherein said image metadata is associated with a series of images taken over a period of time ([0019], note the system may be used to annotate videos).

As to claim **11**, see the rejection of claim **1** and note that Paolini et al. further teaches the method of claim **1** wherein said image metadata is associated with a series of images taken while the location of the image capture device was changing ([0019], the system may be used to capture data associated with video, or see Fig. 3 and note that the method of Fig. 3 may be carried out repeatedly).

Claims **12-17** and **19-22** are apparatus claims that correspond to the method claims **1-6** and **8-11** respectively and are therefore rejected on the same grounds but directed to an apparatus instead of a method.

4. Claims **23** and **24** are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,928,230 (Squibbs)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to claim **23**, Squibbs teaches a storage device 50 for storing image file information comprising: memory fields 7 for storing image data representing pixels in a captured image; memory fields 9 for storing image metadata representing data associated with conditions at the time that the image was captured; and memory fields 8 for storing inference metadata representing data that is generated by searching information databases using at least a portion of the image metadata (see Fig. 3).

As to claim **24**, see the rejection of claim **23** and note that Squibbs further teaches the storage device of claim **23** further comprising: memory fields for storing a confidence factor relating to matched inference data (see, for example, Fig. 15 and note that photos are matched with locations and that some photos are not matched with a location [this would represent the confidence factor], this information is stored in the album and therefore there is necessarily a memory field for it; further see Column 14 lines 1-9) and an identify of a person supervising the match (USER ID, see Fig. 4).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the



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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0114042 (Paolini et al.) in view of US 6,961,096 (Tsujiimoto).

As to claim 7, see the rejection of claim 1 and note that Palini et al. does not specifically discuss the printing of images and associated data. However, Tsujimoto teaches printing image data along with associated meta-data and other descriptive information, such as a location name (See Fig. 6 and Column 8 lines 61-67 and Column 11 lines 41-48). This feature allows for the benefit to the user of being able to identify the circumstances surrounding an image capture including a place name (Column 8 lines 47-51 and Column 11 lines 41-48). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made prints of the images taken by the method of Paulini et al. and to have further printed meta-data and the associated inference data as is done in a method taught by Tujimoto as discussed above as this would allow a user to identify when and where the image was taken.

Claim 18 is an apparatus claim that corresponds to the method claim 7 and is therefore rejected on the same grounds but directed to an apparatus instead of a method.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2004/0021780 (Kogan). US 2002/0076217 (Rodriguez et al.). US 2001/0010549 (Miyake). US 6,995,792 (Ogura). US 6,657,661 (Cazier). US 6,470,264 (Bide). US 6,337,951 (Nakamura). US 6,304,729 (Honda et al.). US 6,222,583 (Matsumura et al.). US 5,768,640 (Takahashi et al.).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dillon Durnford-Geszvain whose telephone number is (571) 272-2829. The examiner can normally be reached on Monday through Friday 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Dillon Durnford-Geszvain

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/John M. Villecco/  
Primary Examiner, Art Unit 2622  
June 18, 2007